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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. CONNOR, DAVID B. HANSON and
KENNETH W. LONG

Appeal 2009-006142
Application 10/658,713
Technology Center 3600

Decided: September 25, 2009

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and
SALLY C. MEDLEY, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

Hewlett-Packard Development Company, L.P. (“HP”), the real party in interest, seeks review under 35 U.S.C. § 134(a) of a Final Rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

References Relied on by the Examiner

Silverberg	4,634,112	Jan. 6, 1987
Miura ¹ et al. (“Miura”)	JP 1-181654	July. 19, 1989

Rejections on Appeal

The Examiner rejected claims 1-10, 12 and 13 under 35 U.S.C. § 102(b) as anticipated by Miura.

The Examiner rejected claims 11 and 16-25 as unpatentable under 35 U.S.C. § 103(a) over Miura.

The Examiner rejected claims 14 and 15 as unpatentable under 35 U.S.C. § 103(a) over Miura and Silverberg.

HP argues separately several different groups of claims, which shall become apparent in the analysis.

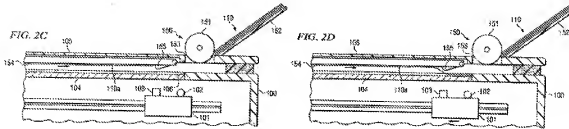
The Invention

The invention is related to an automatic photograph feeder for placing photographic media with an image surface exposed to a passing imaging mechanism, such as a scanner. Spec. 3. HP discloses, referring to HP’s figures 2C and 2D reproduced below [numbers from figures 2C and 2D inserted], a system for de-skewing media when using an automatic media feeder [150] including a registration guide [106] and a registration tab [155]

¹ HP refers to this reference as “Kazunobu”. The Examiner refers to this reference as “JP ‘654”.

disposed to deflect an edge of the media [110a] toward the registration guide [106] when the media [110a] passes over the registration tab [155]. Spec. 3-7.

HP's figures 2C and 2D are below:



Figures 2C and 2D each depict the automatic photographic feeder.

Claim 1, reproduced from the Claim Appendix of the Appeal Brief, reads as follows:

A system for de-skewing media when using an automatic media feeder, said system comprising:
a registration guide; and
a registration tab disposed to deflect an edge of said media toward said registration guide when the media passes over the registration tab.

B. ISSUES

1. Has HP shown that the Examiner incorrectly found that Miura describes a registration tab that: (1) deflects an edge of media toward a registration guide when the media passes over the registration tab; (2) presents a sloped surface to an edge of media when the media moves by the registration tab toward the registration guide; (3) is movable to remain extended when the media is moved past the registration tab toward the registration guide; (4) is movable dependent upon the movement of an attached component of the host

- system; (5) has a triangular shape; and (6) has a smooth outer surface to slidingly direct media?
2. Has HP shown that the Examiner incorrectly found that Miura describes continuing to apply a translation force to media after at least a portion of the first edge of the media engages the registration guide?
 3. Has HP shown that the Examiner erred in determining that it would have been obvious to use photographic media in Miura's copier machine based on the rationale provided by the Examiner?
 4. Has HP shown that the Examiner erred in determining that it would have been obvious to modify Miura's copier machine by replacing the rollers with a feed belt and vacuum orifice as taught by Silverberg based on the rationale provided by the Examiner?
 5. Has HP shown that the Examiner incorrectly found that Miura describes a registration tab that is cast as a monolithic member of a movable lid portion of the host system?

C. FINDINGS OF FACT

1. Triangular is defined as: "of, relating to, or shaped like a triangle." THE AM. HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2004).

HP's Specification

2. HP discloses that automatic document feeders (ADFs) in scanner implementations often implement a "C-shaped" feed path. Spec. ¶ 0002.
3. ADF configurations with a "C-shaped" feed path have been found to work adequately with respect to typical paper stock, such as 20# bond

- paper, but are typically unacceptable for use with other media, such as photo stock or photographic media. Spec. ¶ 0002.
4. Photographic media, for example, is generally more rigid than typical paper stock and is prone to surface scratching, which can seriously degrade the quality of the image thereon. Spec. ¶ 0002.
 5. The thick and rigid nature of the photographic media results in jams and misfeeds, and the photographic image surface results in increased friction when in contact with surfaces (particularly in high humidity environments). Spec. ¶ 0002.
 6. In the Specification, “photographic media” is not explicitly defined as excluding paper stock.

Miura

7. Miura describes, referring to Miura’s figure 1 reproduced below [numbers from figure 1 inserted], an original transport device of a copier which includes a paper feed part [2], a transport part [3] and a paper discharge part [4]. Translation p. 3, ll. 6-18.

Miura’s figure 1 is below:

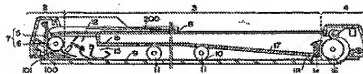


Figure 1 depicts an original transport device of a copier.

8. Miura describes, referring to Miura’s figures 2a and 2b reproduced below [numbers from figures 2a and 2b inserted], the transport part [3] transports originals [200] onto platen glass [100] and includes a butting plate [101], a white sheet [9] and a pressing means [13]. Translation p. 3, l. 25-p. 4, l. 21.

Miura's figures 2a and 2b are below:

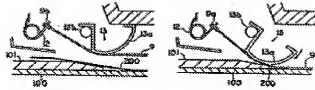


Figure 2 (a)

Figure 2 (b)

Figures 2a and 2b depict the transport part of original transport device.

9. The pressing means [13] includes a pressing plate [13a] which has a smooth convexly curved outer surface. Translation p. 4, ll. 14-17.
10. White sheet [9] is made of a plastic material rich in solid lubricating ability. Translation p. 3, ll. 27-28.
11. Originals [200] are fed between the platen glass [100] of the copier and the white sheet [9] by the transport part [3]. Translation p. 4, ll. 33-34.
12. During transport, as shown in figure 2a, white sheet [9] is raised above platen glass [100] so that originals [200] do not touch the white sheet [9] to make transport of the original smooth. Translation p. 4, ll. 10-12; p. 4, l. 34-p. 5, l. 2.
13. The originals [200] are fed backward to butt against the butting plate [101] and are exposed. Translation p. 2, ll. 26-27; fig. 2b.
14. Original transport rollers [11] (fig. 1) are used for transporting the original [200] on platen glass [100]. Translation p. 4, l. 3-8.
15. Miura explains that when the originals [200] are fed backward and stopped by the butting plate [101], and when there is a gap between the white sheet [9] and the butting plate [101], there is the risk of a problem occurring if the original [200] slips over the butting plate [101] and returns to the paper feed part [2]. Translation p. 2, ll. 27-30.

16. Miura addresses this problem by providing a sheet pressing means [13] that can open and close the gap between the sheet [9] and butting plate [101]. Translation p. 3, ll. 9-10, p. 5, ll. 15-17.
17. During exposure, originals [200] are fed backward once and stop, touching butting plate [101], and at this time the pressing means [13] is pressing white sheet [9] which is touching butting plate [101] so originals will not skip over butting plate [101] and return toward paper feed part [2]. Translation p. 5, ll. 2-6; fig. 2b.
18. A satisfactory exposure state is realized because originals [200] are pressed tightly against platen glass [100] by white sheet [9] during exposure. Translation p. 3, ll. 26-27; p. 5, ll. 6-7; fig. 2b.
19. Original transport rollers [11] (fig. 1) can also turn forward or backward to fine tune the final position of the original [200] during exposure. Translation p. 4, ll. 8-9.
20. When Miura's originals [200] are fed backward, as depicted in figure 2b, an edge of the original [200] (i.e., the leading edge) passes over at least a portion of the pressing means [13], and the pressing means [13], by way of white sheet [9], deflects the original [200] toward the butting plate [101] and platen [100].
21. When Miura's originals [200] are fed backward, the smooth convexly curved surface of the pressing means [13] is presented to the edge (i.e. the leading edge) of the original [200] as it passes over at least a portion of the pressing means [13].
22. It is well known and ubiquitous to use a copier in order to copy photographs.

23. One with ordinary skill in the art would appreciate that a photograph such as would be embodied on photographic media could be used in Miura's copier in order to make copies of the photograph.

Silverberg

24. Silverberg describes, referring to Silverberg's figure 6 reproduced below [numbers from figure 6 inserted], a document handling system [10] in which a platen transport system [12] includes a vacuum plenum or manifold [24] with a plenum backing or imaging surface [26] closely overlying a platen [14]. Col. 7, ll. 50-61; col. 8, ll. 16-19.

Silverberg's figure 6 is below:

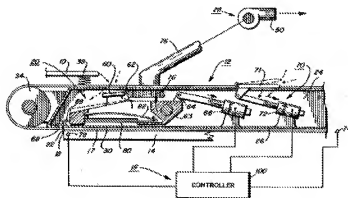


Figure 6 depicts a document handling system.

25. The backing surface [26] is closely overlaid with a plurality of moving transport belts [30]. Col. 8, ll. 20-21.
26. Silverberg describes that it is known in the art that there is a need to reduce the document transporting force just as the document reaches the registration position to avoid over-driving the document against registration fingers. Col. 5, ll. 5-9.

D. PRINCIPLES OF LAW

It is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that

a person of ordinary skill in the art would employ can be taken into account. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421.

“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). But, “limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citation omitted).

“A [prior art] reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect.” *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (emphasis omitted). “‘The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, as they are a part of the literature and are relevant for all they contain.’” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983), citing *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968).

E. ANALYSIS

Anticipation of Claims 1-3, 7, 9 and 10 by Miura

Independent claim 1 is representative and recites (disputed limitations *in italics*): “a registration guide; and *a registration tab disposed to deflect an*

edge of said media toward said registration guide when the media passes over the registration tab.” Appeal Br. 24, Claim App’x.

The Examiner finds that Miura describes a registration guide (i.e., butting plate [101]) and a registration tab (i.e., pressing means [13]), where a white sheet [9] serves as an intermediate feature of the pressing means [13]. Final Rejection 2; Ans. 3, 7; Translation p. 3, l. 25-p. 4, l. 21. The Examiner further finds that Miura’s figure 2b shows the pressing means [13] in the deflecting position in which the sloped surface of the pressing means [13] acts on the white sheet [9], which then acts on original [200] to deflect the original [200] downward onto platen [100] and into abutting alignment with the butting plate [101]. Ans. 6.

HP argues that Miura’s pressing means [13] (i.e., registration tab) does not present a sloped surface to original [200] (i.e., media) and is at all times separated from original [200] by white sheet [9]. App. Br. 5. HP’s arguments are not commensurate in scope with the claim limitations. Claim 1 does not recite that the registration tab presents a sloped surface. The claim language also does not require direct contact between the registration tab and the media.

HP further argues that Miura’s original [200] does not pass over pressing means [13], and the pressing means [13] is not disposed to deflect an edge of original [200]. App. Br. 5; Reply Br. 3. HP apparently is arguing that Miura’s entire original [200] must pass over the entire pressing means [13]. Such an argument is not commensurate in scope with the claim limitations. The claim language does not require the entirety of the media to pass over the entire registration tab. App. Br. 24, Claim App’x. All that is

required is for just a portion of the media to pass over just a portion of the registration tab.

Miura describes that during exposure, originals [200] are fed backward once and stop, touching butting plate [101], and at this same time, the pressing means [13] is pressing white sheet [9] which is touching butting plate [101] so originals will not skip over butting plate [101] and return toward paper feed part [2]. Translation p. 5, ll. 2-6; fig. 2b. When Miura's originals [200] are fed backward, as depicted in figure 2b, an edge of the original [200] (i.e., the leading edge) passes over at least a portion of the pressing means [13], and the pressing means [13] by way of white sheet [9], deflects the original [200] toward the butting plate [101] and platen [100].

Even HP appears to acknowledge that Miura's original [200] is deflected toward butting plate [101] by pressing means [13] in cooperation with the white sheet [9]. Specifically, HP argues that it "believes original [200] travels flat on the surface of platen glass [100] toward butting plate [101] due to the force of gravity and the force sheet [9] exerts on it." App. Br. 6. HP further argues that "figure 2b shows sheet [9] pushing original [200] down", and that the pressing means [13] "is applying a biasing force to the sheet [9]." Reply Br. 3.

For all these reasons, HP has not shown that the Examiner erred in finding claim 1-3, 7, 9 and 10 anticipated by Miura.

Anticipation of Claim 4 by Miura

Claim 4 is dependent on claim 1 and further recites: "said registration tab comprises a member presenting a sloped surface to said edge of said media when the media moves by said registration tab toward said registration guide." App. Br. 24, Claim App'x. 24.

HP presents identical arguments to those addressing the limitations of claim 1. *Compare* App. Br. 7; Reply Br. 4-5 with App. Br. 5.

Similar to the arguments presented addressing claim 1, HP appears to argue that the limitation “presenting a sloped surface to said edge of the media” requires direct contact between the media and the sloped surface. Claim 4 does not require direct contact between the sloped surface of the registration tab and the media.

Similar to our explanation above, when Miura’s originals [200] are fed backward to abut the butting plate [101], the smooth convexly curved surface of the pressing means [13] is presented to the edge (i.e. the leading edge) of the original [200] as it passes over at least a portion of the pressing means [13]. The pressing means [13] presents its convexly curved surface to the original [200] while it is located in the path of the original [200] as it is fed backward, as shown in figure 2b.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in finding claim 4 anticipated by Miura.

Anticipation of Claims 5 and 6 by Miura

Claims 5 and 6 are dependent on claim 1. Claim 5 further recites: “said registration tab is movable to . . . remain extended when said media is moved past said registration tab toward said registration guide.” App. Br. 24, Claim App’x.

HP argues that Miura does not describe the limitations of claim 5 because Miura’s original [200] does not move past the pressing means [13]. App. Br. 7. HP argues that instead the original [200] stops at pressing means [13] because white sheet [9] is pressed to butting plate [101] by pressing

means [13] to prevent the original [200] from feeding over the butting plate [101]. App. Br. 7. We again understand HP to mean that the entirety of the media must move past the entire registration tab. Claim 5 does not require the entirety of the media to pass the registration tab. The Examiner finds that Miura describes that part of the original [200] is moved past the pressing means [13]. Ans. 7. HP does not address or dispute the Examiner's finding in its Reply Brief.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in finding claims 5 and 6 anticipated by Miura.

Anticipation of Claim 8 by Miura

Claim 8 is dependent on claim 1 and further recites: "said registration tab is not movable independent of moving a component of a host system to which said registration tab is attached." App. Br. 24, Claim App'x.

Without saying more, HP argues that Miura does not describe the limitations of claim 8 because Miura's pressing means [13] is movable independent of all other components of device [1]. App. Br. 8.

The Examiner finds that pressing means [13] is disposed on drive shaft [13b] which is moved by motor. Ans. 7. The Examiner further finds that pressing means [13] is not freely disposed on the drive shaft [13b] and only moves when moved by the motor of the host system. Ans. 7-8.

HP's arguments are unpersuasive because they do not offer a meaningful explanation of why the Examiner's findings are erroneous. HP also does not dispute the Examiner's findings in its Reply Brief.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in finding claim 8 anticipated by Miura.

Anticipation of Claim 12 by Miura

Claim 12 is dependent on claim 1 and further recites: “said registration tab has a smooth outer surface to slidingly direct said media.” App. Br. 25, Claim App’x.

The Examiner finds that Miura’s white sheet [9] serves as an extension of the surface of the pressing means [13] (i.e., registration tab) and is the smooth outer surface of the pressing means [13]. Ans. 8. The Examiner also finds that Miura describes the pressing means [13] as having a smooth outer surface. Ans. 8, citing Miura p. 4, ll. 15-17.

HP presents similar arguments to those addressing claim 1. *Compare* App. Br. 8; Reply Br. 5 *with* App. Br. 5. HP additionally argues that regardless of whether sheet [9] serves as an extension of pressing means [13], white sheet [9] is not a sloped surface of the pressing means [13]. Reply Br. 5.

HP’s additional argument is not commensurate in scope with the limitations of claim 12. Claim 12 does not require the registration tab to have a one piece construction or to have a sloped surface.

HP also argues that the surface of pressing means [13] does not slidingly direct original [200]. App. Br. 8; Reply Br. 5. HP does not contest the Examiner’s findings that Miura’s pressing means [13] and white sheet [9] are smooth. Miura describes the pressing means [13] as including a smooth convexly curved outer surface and describes the white sheet [9] as made of a plastic material rich in solid lubricating ability. Translation p.3, ll.

27-28; p. 4, ll. 14-17. Miura's pressing means [13] in cooperation with white sheet [9] slidably directs an original [200] because the pressing means [13] presses the lubricious (i.e., slippery) plastic white sheet [9] to press the originals against the platen [101]. Translation p. 3, ll. 26-28; p. 5, ll. 6-7; fig 2b.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in finding claim 12 anticipated by Miura.

Anticipation of Claim 13 by Miura

Claim 13 is dependent on claim 1 and further recites: "said registration tab has a triangular shape." App. Br. 25, Claim App'x. The Examiner and HP disagree as to whether Miura's pressing means [13] (i.e., registration tab) has a triangular shape. Final Rejection 2; Ans. 3; App. Br. 9.

HP does not explain, in any meaningful way, why the Examiner's finding is erroneous. App. Br. 9. We hold that the term "triangular" means "shaped like a triangle", i.e., triangular-like. Miura's pressing means [13] is shaped *like* a triangle in that it has three sides and three corresponding corners. To the extent that Miura's pressing means [13] is not a geometric triangle because it has a curved or convex side, we note that HP's registration tab [155] also has at least one curved or convex side.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in finding claim 13 anticipated by Miura.

Obviousness of Claims 16-20 over Miura

Claim 16 is independent and recites (disputed limitations in *italics*): a method . . . comprising: disposing a registration tab to cooperate with a registration guide . . . *translating said media in a first direction to pass a first edge of said media by said registration tab; deflecting with said registration tab said first edge toward said registration guide; and continuing to apply a translation force to said media after at least a portion of said first edge engages said registration guide . . .*” App. Br. 25, Claim App’x.

HP argues that Miura does not describe the disputed claim limitations and presents substantially the same arguments as those already presented for claims 1-4, 7, 9, 10 and 12. *Compare* App. Br 10-13 with App. Br. 5-8; Reply Br. 4-5.

HP additionally argues that Miura does not describe continuing to apply a translation force to the media after at least a portion of the first edge engages the registration guide. HP argues that Miura does not describe this limitation because sheet [9] is pressed to the butting plate to stop original [200] and prevent it from feeding over the butting plate [101]. App. Br. 12-13.

The Examiner finds that Miura describes the disputed limitations because if the pressing means [13] was not used, the original [200] when fed backward would be fed over and beyond the butting plate [101]. The Examiner finds, that rather, Miura describes that a continued application of translation force is applied to the original [200] after reaching the butting plate [101]. Final Rejection 6; Ans. 8.

HP's arguments are misplaced because they focus on the actual translation of Miura's original [200] rather than the *translation force applied* to the Miura's original [200]. HP's argument that the translation of Miura's original [200] is stopped does not mean that the translation forces applied to the original [200] to feed it backward are also stopped. As explained by the Examiner, but for the pressing means [13] stopping the original [200], the original [200] would feed over the butting plate [101] due to the continued application of a translation force to the original [200].

Moreover, Miura describes continuing to apply a translation force to the original [200] after an edge of the media engages the butting plate [101] because during exposure (i.e., after original [200] is fed backward) the original transport rollers [11] can also turn forward or backward to fine tune the final position of the original [200]. Translation p. 4, ll. 8-9.

For all these reasons, in addition to those discussed above with respect to claims 1-4, 7, 9 and 12, HP has not shown that the Examiner erred in determining that claims 16-20 are obvious over Miura.

Obviousness of Claim 11 over Miura

Claim 11 is dependent on claim 1 and further recites: "said media comprises photographic media." App. Br. 25, Claim App'x.

The Examiner finds that Miura does not specifically teach that the media comprises photographic media. Final Rejection 3; Ans. 4. The Examiner determined that it would have been obvious to one with ordinary skill in the art at the time the invention was made to use photographic media with Miura's system if one desired to be able to photocopy and scan photographs. Final Rejection 3; Ans. 4.

HP argues that Miura does not teach or suggest photographic media nor suggest the desirability of the combination. App. Br. 9-10; Reply Br. 6, 9. HP argues that the Examiner does not establish the desirability for making the modification, but merely provides a statement that the references can be modified. App. Br. 10.

HP's arguments are misplaced because it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed. *KSR* at 418. Inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *Id.* 418.

At the time of the invention, it was well known and ubiquitous to use a copier machine, like Miura's, to make copies of photographs. One with ordinary skill in the art would have appreciated that a photograph, such as would be embodied on photographic media, could have been used in Miura's copier in order to make copies of the photograph.

HP does not direct us to objective evidence to demonstrate that it would have been beyond the level of ordinary skill in the art to use photographic media with Miura's system if copying of photographic media content was desired. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421.

HP further argues that it would not have been obvious to use photographic media with Miura's copier because Miura teaches a C-shaped feed path. App. Br. 10. HP points out that its Specification discloses that C-shaped feed paths work adequately with respect to typical paper stock, but are typically unacceptable for use with other media such as photographic media. App. Br. 10, citing Spec. ¶ 0002. HP further argues that the thick rigid nature of photographic media results in jams and misfeeds. App. Br.

10; citing Spec. ¶ 0002. HP argues that photographic media might be damaged by using a take-up mechanism with a C-shaped feed path. HP concludes that one with ordinary skill in the art would not have been motivated to use photographic media with Miura's system. App. Br. 10; Reply Br. 6.

HP does not direct us to objective evidence to demonstrate that it would be unacceptable or problematic to use photographic media in Miura's copier machine. Argument of counsel cannot take the place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Moreover, HP's arguments are premised on a narrow meaning of "photographic media" as having a structure that is thick and rigid. Claims are given the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *Morris*, 127 F.3d at 1054. "[L]imitations are not to be read into the claims from the specification." *Van Geuns*, 988 F.2d at 1184. HP does not direct us to, and we can not find, an explicit definition for the term "photographic media" in its Specification. While HP's Specification discloses that "photographic media, *for example*, is generally more rigid than typical paper stock" Spec. ¶ 0002 (emphasis added), that is but one example. The Specification does not explicitly define "photographic media" as excluding paper stock. Moreover, HP does not direct us to objective evidence to demonstrate that one with ordinary skill in the art would attribute such a narrow meaning to the term. One with ordinary skill in the

art would understand that photographic media is any media upon which photographs are printed and can include typical paper stock such as the sheet media explicitly described in Miura.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in determining that claim 11 is obvious over Miura.

Obviousness of Claims 21-22 and 24-25 over Miura

Claim 21 is independent and recites (disputed limitations in *italics*): “[a]n automatic photograph feeder comprising: . . . a registration tab; and *a media translation mechanism disposed to . . . cause an edge of the media to engage said registration tab, wherein engaging said registration tab by said edge causes said edge to deflect towards a registration guide.*” Appeal Br. 26, Claim App’x.

HP argues that Miura does not describe the disputed claim limitations for substantially the same reasons as those addressing claims 1-4, 7, 9 and 10. *Compare* App. Br. 14-16 *with* App. Br. 5-7.

HP also argues that it would not have been obvious to one with ordinary skill in the art to use photographic media in Miura’s system for substantially the same reasons as those addressing claim 11. *Compare* App. Br. 16-17 *with* App. Br. 9-10.

For the same reasons as those explained before addressing claims 1-4, 7, 9 and 10 and addressing claim 11, HP has not shown that the Examiner erred in determining that claims 21-22 and 24-25 are obvious over Miura.

Obviousness of Claim 23 over Miura

Claim 23 is ultimately dependent on claim 21 and recites: “said registration tab is cast as a monolithic member of said movable lid portion of said host system.” App. Br. 26, Claim App’x.

The Examiner finds that Miura teaches a registration tab cast as a monolithic member of the movable lid portion “in the sense that a monolithic member acts as a single powerful force to deflect the sheet media.” Ans. 9.

HP argues that Miura does not describe the disputed limitations because Miura’s pressing means [13] is a not cast as a monolithic member of the movable lid, but is a separate member. Reply Br. 17.

Even though claims are broadly interpreted during prosecution, that interpretation must still be reasonable. The Examiner’s interpretation of the meaning of “monolithic member” is unreasonable because it ignores the context in which the terms are used in the claim. Claim 23 recites that “the registration tab is *cast* as a monolithic member”; the process by which the monolithic member is constructed. Based on the context of the claim language, one with ordinary skill in the art would understand that a monolithic member means a single-piece construction, rather than “a single powerful force to deflect the sheet media”.

The Examiner does not direct us to, and we can not find where Miura describes a registration tab that is cast as a monolithic member (i.e., one-piece construction) of a movable lid portion of the host system.

For these reasons, the Examiner erred in determining that claim 23 would have been obvious over Miura.

Obviousness of Claims 14 and 15 over Miura and Silverberg

Claim 14 is dependent on claim 1 and further recites: “a feed belt to provide translation of said media and thereby move said media past said registration guide in a direction of said registration guide.” App. Br. 25, Claim App’x. Claim 15 depends from claim 14 and further recites: “a vacuum orifice providing a reduced pressure area to cooperate with said feed belt in providing translation of said media.” App. Br. 25, Claim App’x.

The Examiner finds that Miura does not describe a feed belt or a vacuum operating with a feed belt. Final Rejection 3; Ans. 4. The Examiner finds that Silverberg teaches vacuum belts in a document feeder. Final Rejection 3; Ans. 4. The Examiner determined that it would have been obvious to one with ordinary skill in the art at the time the invention was made to use Silverberg’s vacuum feed belts in place of the rollers taught by Miura if one desired to reduce the initial skew of the sheets by using belts rather than rollers and to prevent damaging the sheets by over-driving the sheets into the registration guide. Final Rejection 3; Ans. 4.

HP argues that the motivation provided by the Examiner is improper because the prior art does not suggest the desirability of the combination or suggest that such a modification would result in any improvement in the system of the primary reference. App. Br. 20-21. HP’s arguments are misplaced since it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed. *KSR* at 418. Inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *Id.*

Without saying more, HP also argues that the Examiner improperly dissected the elements of the claimed invention for evaluation in isolation

rather than considering the claimed invention as a whole. App. Br. 20, 22. HP's argument is unpersuasive because it does not provide a meaningful explanation of any error on the part of the Examiner.

Specific to claim 14, HP argues that Silverberg attributes the benefits of its system to a platen transport system which comprises both a belt transport system and a vacuum transport system, not to a belt transport system alone, as required by claim 14. App. Br. 19. HP's argument is not commensurate in scope with the limitations of claim 14. Claim 14 is an open-ended claim utilizing the transitional phrase "comprising", thus a vacuum transport system is not excluded from the scope of the claim. Claim 14 also does not include language that precludes a vacuum transport system.

Specific to claim 15, HP argues that the proposed modification will render the Miura reference unsatisfactory for its intended purpose. App. Br. 21-22. HP argues that it "believes that original [200] travels flat on the surface of platen glass [100] toward butting plate [101] due to the ever present force of gravity and the force sheet [9] exerts on it." App. Br. 22. HP also argues that replacing Miura's rollers with Silverberg's vacuum feed belts would require the removal of white sheet [9] from Miura's copier machine. App. Br. 22. HP further argues that removing white sheet [9] would destroy Miura's purpose of preventing original [200] from feeding over the butting plate [101]. App. Br. 22.

HP does not direct us to objective evidence demonstrating that Miura's original [200] travels flat on the surface of platen glass [100] toward butting plate [101] due to the force sheet [9] exerts on the original [200]. Further, HP's arguments are misplaced because Miura describes that it is the original transport roller [11] which transports the original [200] on platen

glass [100]. Translation p. 4, l. 3. Miura describes that originals [200] are pressed tightly against platen glass [100] by white sheet [9] during exposure, but the original transport rollers [11] can also turn forward or backward to fine tune the final position of the original [200]. Translation p. 3, ll. 26-27; p. 4, ll. 8-9; p. 5, ll. 6-7; fig 2b. HP does not otherwise provide a cogent explanation why substituting Silverberg's vacuum feed belt for Miura's rollers [11] would necessitate the removal of white sheet [9] from Miura's apparatus and destroy Miura's intended purpose.

For all these reasons, in addition to those discussed above with respect to claim 1, HP has not shown that the Examiner erred in determining that claims 14 and 15 are obvious over Miura and Silverberg.

F. CONCLUSIONS

1. HP has not shown that the Examiner incorrectly found that Miura describes a registration tab that: (1) deflects an edge of media toward a registration guide when the media passes over the registration tab; (2) presents a sloped surface to an edge of media when the media moves by the registration tab toward the registration guide; (3) is movable to remain extended when the media is moved past the registration tab toward the registration guide; (4) is movable dependent upon the movement of an attached component of the host system; (5) has a triangular shape; and (6) has a smooth outer surface to slidingly direct the media.
2. HP has not shown that the Examiner incorrectly found that Miura describes continuing to apply a translation force to media after at least a portion of the first edge of the media engages the registration guide.

3. HP has not shown that the Examiner erred in determining that it would have been obvious to use photographic media in Miura's copier machine based on the rationale provided by the Examiner.
4. HP has not shown that the Examiner erred in determining that it would have been obvious to modify Miura's copier machine by replacing the rollers with a feed belt and vacuum orifice as taught by Silverberg based on the rationale provided by the Examiner.
5. HP has shown that the Examiner incorrectly found that Miura describes a registration tab that is cast as a monolithic member of a movable lid portion of the host system.

G. ORDER

The decision of the Examiner rejecting claims 1-10, 12 and 13 under 35 U.S.C. § 102(b) as anticipated by Miura is affirmed.

The decision of the Examiner rejecting claims 11, 16-22 and 24-25 as unpatentable under 35 U.S.C. § 103(a) over Miura is affirmed.

The decision of the Examiner rejecting claim 23 as unpatentable under 35 U.S.C. § 103(a) over Miura is reversed.

The decision of the Examiner rejecting claims 14 and 15 as unpatentable under 35 U.S.C. § 103(a) over Miura and Silverberg is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

Appeal 2009-006142
Application 10/658,713

ack

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